

REMARKS/ARGUMENTS

Posture of the Application

Claims 1-20 are presently pending, with claims 9-11 and 16-19 withdrawn from consideration. Claims 1, 4, 8/1, 13, 15/1 and 20 stand rejected under 35 U.S.C. 103(a). Claims 2, 3, 5-7, 8/3, 8/5, 8/7, 12, 14, 15/3, 15/5, 15/7 and 15/14 are objected to as being dependent upon a rejected base claim, but otherwise are found to be allowable. Applicant herein requests amendment of the claims objected to by the Examiner, substantially in the manner suggested by the Examiner, to place the amended claims in condition for allowance. In addition, withdrawn claims 9-11 and 16 have been cancelled. Withdrawn claims 17-19 have not been cancelled, for the reasons discussed below.

Entry of Amendments After Final Rejection

It is submitted that the proposed amendments after final rejection may properly be entered because, with only the exceptions discussed below, the amendments conform the claims to those indicated by the Examiner to be allowable, and cancel withdrawn claims 9-11 and 16.

The exceptions to the conforming amendments are (1) not all of allowable dependent claim 5 was incorporated into claim 1, and (2) a more detailed version of claim 14 has been incorporated into claim 13, and claim 14 has been cancelled. Item (1) is discussed below; item (2) reduces the number of claims and issues on appeal. The details added to claim 13 as now presented herein find support in the application as filed, e.g., paragraph [0043] at page 9. No new issues are raised by the requested amendment of claim 13 nor is additional search required in view of the Examiner's finding of allowability of comparable claims.

Claim 4 has been cancelled as its substance, plus other limitations, have been incorporated into claim 1. Claims 8/1 and 15/1 have also been cancelled simply because they are superfluous in light of the claim coverage provided by the several dependencies of claims 8 and 15.

Withdrawal of Claims

It appears that claims 17-19 were erroneously withdrawn from consideration, as these claims merely further define the guide member defined in claim 13. Applicant has therefore not cancelled claims 17-19 and requests that they be retained for consideration in this application. In a telephone conversation with the Examiner, the Examiner stated that if claim 13 is found to be allowable, consideration would be given to reinstating claims 17-19. It is suggested that even if the rejection of claim 13 were to be maintained, claims 17-19 should be reinstated for purposes of consideration on appeal.

Allowable subject matter. At page 3 of the office action, claims 2, 3, 5-7, 8/3, 8/5, 8/7, 12, 14, 15/3, 15/5, 15/7 and 15/14 were objected to as being dependent upon a rejected base claim, but were stated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With the sole exception discussed below, the claims have been so amended and are now believed to be in condition for allowance including the claim (claim 1) which was amended in modified fashion.

As set forth in the office action, claim 5 as then presented was deemed to contain allowable subject matter. Claim 5 is dependent on claim 1 and some, but not all of the limitations of claim 5, have been incorporated into claim 1 as presented in this paper. It is believed that, nonetheless, claim 1 as proposed to be amended herein is now in condition for allowance. Claim 5 defined the strap winder of claim 1 wherein the power source comprises a battery-containing electrical system associated with the vehicle, and that portion of claim 5 has been incorporated into claim 1. The portions of claim 5 which define that the strap winder is in combination with, and mounted upon, the vehicle have not been incorporated into claim 1 but remain in dependent claim 5.

As amended, claim 1 is believed to patentably distinguish over the cited prior art which fails to show or suggest a strap winder powered by the electrical system of a vehicle. Claim 1 as presented herein is thus written in a fashion parallel to claims 2 and 6 (pneumatic and hydraulic power sources, respectively), which have been amended in accordance with the Examiner's requirement to place those claims in condition for allowance.

Claim Rejections Under 35 U.S.C. § 103

Claims 1, 4, 8/1, 13, 15/1 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,954,226 to Pickering in view of U.S. Patent No. 4,161,298 to Davis. The Examiner states that Pickering recites the elements of claims 1 and 13 "except for a power-operated driver and a power connector". Davis is relied upon by the Examiner to remedy the acknowledged deficiency of Pickering, the Examiner stating that it would have been obvious "to provide Pickering with a power-operated driver and power connector as taught by Davis so that winding of the straps can be done more quickly without tiring out of the user." Applicant respectfully traverses this ground of rejection.

As presented herein, claim 1 requires both that the power-operated driver comprise an electric motor and the power source contain a battery-containing electrical system associated with a vehicle. The Davis reference merely discloses a conventional electric motor on which an auxiliary shaft is mounted (Figure 3) and fitted with a guide assembly to facilitate winding bandages. Davis lacks at least the claimed features of a one-piece shaft and a power source comprising a battery-containing electrical system associated with a vehicle. It is respectfully submitted that claim 1, as proposed to be amended herein, and the claims dependent thereon, are patentable over the combined references.

For an obviousness rejection to be sustainable, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re I'ine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The combination and modification of references as set forth in the office action is not proper and does not render the claims obvious under 35 U.S.C. 103 unless the prior art also suggests the desirability of the combination. See *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990), *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) and MPEP § 2143.01. In the *Mills* case, the court held that although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 16 USPQ2d at 1432. (Emphasis added.)

If the proposed modification of the reference would render the modified reference unsatisfactory for its intended purpose or change its principle of operation, then there is

no suggestion or motivation to the art to make the proposed modification and the combined or modified references are not capable of sustaining a rejection under 35 U.S.C. 103. See also *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984) and *In re Ratti*, 123 USPQ 349 (CCPA 1959). In the latter case, the court reversed the rejection, holding that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." (Emphasis added.) 123 USPQ at 352 (CCPA 1959.). MPEP §2143.01.

As noted above, Davis discloses an ordinary electric motor 10 of conventional construction (column 2, lines 31-33) which, of necessity, requires connection to a conventional land line source of electric power. Thus, modification of the hand-held and hand-operated device of Pickering by Davis as suggested by the Examiner would render the modified Pickering device unsatisfactory for its intended purpose, i.e., "to provide a portable inexpensive means for use in wrapping coils of straps" (col. 2, lines 15-17, emphasis added) and "to provide a strap coiling mechanism which is quickly and easily disassembled" (col. 2, lines 19-21). Pickering attains these objectives by providing a simple, hand-held, hand-operated, two-piece device. Davis discloses a conventional electric motor having winding devices 18, 18' connected to opposite protruding shafts of the motor. Pickering's objectives of portability and quick and easy (manual) disassembly would be entirely defeated by providing it with a power-operated driver and power connector, as proposed by the Examiner. The proposed modification of Pickering would also change its principle of operation from hand-operated to power-operated.

Accordingly, it is respectfully submitted that there is no suggestion or motivation to the art to make the Examiner's proposed modification, which is therefore an improper one, as it is based on hindsight reasoning.

As to claim 13, aside from the impropriety of the combination of references as discussed above, the (improperly) combined references fail to show or suggest the defined (as amended herein) combination of a strap winder in combination with a vehicle wherein the strap winder is powered by an electric, pneumatic or hydraulic power source of the vehicle.

Conclusion

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued.

If the Examiner concludes that an interview with the undersigned will advance prosecution of this application, the Examiner is cordially invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

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